

R E M A R K S

Claims 1-34 stand as originally filed. Re-examination and reconsideration are requested.

In the office action, dated June 28, 2005, the examiner rejected claims 1-7, 9-12, 14-22, 24-27, and 29-34 under 35 U.S.C. §102(b) as being anticipated by Mitchell, *et al.*, U.S. Patent No. 5,963,966 (Mitchell). The examiner rejected claims 8 and 23 under 35 U.S.C. §103(a) as being unpatentable over Mitchell. The examiner rejected claims 13 and 28 under Section 103(a) as being unpatentable over Mitchell in view of Block, *et al.*, U.S. Patent No. 6,295,543 (Block).

Re the Section 102 Rejections:

The examiner rejected claims 1-7, 9-12, 14-22, 24-27, and 29-34 as being anticipated by Mitchell. These rejections are improper in that Mitchell does not meet at least the limitations of the claims that relate to "using said one or more indicia to locate said network data, said network data being maintained at another device operatively associated with the network." Because Mitchell fails to meet at least this limitation, Mitchell cannot anticipate any of the pending claims.

Claim 1 of the present invention is directed to a method for accessing network data associated with a document that involves converting at least a portion of the document to electronic format, the at least a portion of the document having one or more indicia thereon; analyzing the at least a portion of the document to obtain the indicia; using the indicia to locate network data; and accessing the network data. Stated another way, claim 1 is directed to a method wherein indicia provided on a document are analyzed and used to access network data located on another device associated with the network.

In contrast, the Mitchell reference discloses a system for automatically converting paper documents into hypertext-based documents so that the documents, which are now in electronic

form, can be accessed through electronic networks. The Mitchell invention generalizes the concept of form-based recognition while extending the concept of document retrieval to include document structure knowledge, thereby providing the advantages found in both form-based recognition and image-based information retrieval. In one embodiment, a method of the invention enables direct translation of a paper document into a hypertext-based format so that it may be directly accessed through the Internet. In short, Mitchell describes an automated document formatting system for converting paper documents into electronic documents. Significantly, Mitchell does not disclose or suggest using any indicia on the document itself to locate **other** information (i.e., "network data" in the language of the pending claims) being maintained on another device associated with the network.

In supporting his rejections, the examiner asserts that Figure 2 of Mitchell meets the limitations of the pending claims that relate to "using said one or more indicia to locate said network data." However, this assertion mis-reads Mitchell. The indexing process referred to by Mitchell in Figure 2 and described in lines 60-65 of col. 2 relates to indexing the document itself, i.e., so that the electronic document itself may be searched and/or located by the index created from the document. Nowhere does Mitchell disclose or suggest that the index of the document may be used to retrieve any other information (i.e., "network data") maintained at another device associated with the network. Because this limitation of claim 1 is not disclosed or suggested by Mitchell, Mitchell cannot anticipate claim 1.

Dependent claims 2-14 are allowable at least because they depend from claim 1, which is prima-facia allowable.

Independent claim 15 is directed to apparatus for accessing network data associated with a document. Claim 15 includes "program code for using said one or more indicia to locate said network data, said network data being maintained at another device operatively associated with the network." Mitchell does

not meet this limitation for the reasons expressed above for claim 1. That is, while it is true that Mitchell uses the document to create an index of the document, Mitchell does not disclose using that document index to locate network data maintained at another device operatively associated with the network. Because Mitchell fails to disclose or suggest this limitation of claim 15, Mitchell cannot anticipate claim 15.

Dependent claims 16-28 are allowable at least because they depend from claim 15, which is allowable.

Independent claim 29 is directed to a system for accessing network data associated with a document. Claim 29 includes "program code for using said one or more indicia to locate said network data, said network data being maintained at another device operatively associated with the network." Mitchell does not meet this limitation for the reasons expressed above for claims 1 and 15. That is, while Mitchell discloses using the document to create an index of the document itself, Mitchell does not disclose using that document index to locate network data maintained at another device operatively associated with the network. Because Mitchell fails to disclose or suggest this limitation of claim 29, Mitchell cannot anticipate claim 29.

Dependent claims 30-33 are allowable at least because they depend from claim 29, which is allowable.

Independent claim 34 is directed to apparatus for accessing network data associated with a document. Claim 34 includes "means for using said means for locating said network data to locate said network data, said network data being maintained at another device operatively associated with the network." Mitchell does not meet this limitation for the reasons expressed above for claims 1, 15, and 29. That is, while Mitchell uses the document to create an index of the document, Mitchell does not disclose using that document index to locate network data maintained at another device operatively associated with the network. Because Mitchell fails to disclose or suggest this limitation of claim 34, Mitchell cannot anticipate claim 34.

Re the Section 103 Rejections:

The examiner rejected claims 8 and 23 as being obvious over Mitchell and rejected claims 13 and 28 as being obvious over Mitchell in view of Block. These rejections are improper in that the references, taken alone or in combination, fail to provide the suggestion or incentive to modify them in the manner urged by the examiner. Consequently neither reference can be used to establish the required prima-facie case of obviousness.

With regard to claims 8 and 23, the examiner takes official notice that e-mail is received through the Internet. While this is true, nothing in Mitchell provides the suggestion or incentive to make this modification. That is, because Mitchell does not disclose or suggest using indicia found on a document to locate network data maintained on another device associated with the network, there is no need in Mitchell, thus no suggestion or incentive, to use e-mail for anything, much less in the manner required by claims 8 and 23.

Indeed, this deficiency in Mitchell's teachings simply highlights the points made above with regard to the examiner's anticipation rejections under Section 102. That is, because Mitchell does not use the index created from the document to do anything other than locate the document itself, Mitchell cannot possibly provide the suggestion or incentive to modify his device to locate by any means (much less by e-mail) network data maintained at another device on the network. Stated another way, even if Mitchell's system were modified to receive email via the Internet, the resulting system would fail still to meet at least the limitations of claims 8 and 23 that relate to "using said one or more indicia to locate said network data," as described above with regard to the anticipation rejections. Consequently, claims 8 and 23 are not obvious over Mitchell.

With regard to claims 13 and 28, the examiner utilizes the Block reference in an attempt supply the limitations of claims 13 and 28 that relate to using the word frequency to locate the network data. While the Block reference does disclose

determining word frequency, Block uses the word frequency for a different purpose. More specifically, Block uses the word frequency to calculate "the empirical correlation between a word and a class according to Pearson H. Weber, 'Einführung in die Wahrscheinlichkeitsrechnung und Statistik für Ingenieure.'" See Block at col. 2, lines 47-51. However, using word frequency to calculate an empirical correlation between a word and a class is not the same as the limitations of claims 13 and 28 which include at least "using the results of said frequency comparison to locate said network data."

What is also missing from Block and Mitchell is some teaching or suggestion that would motivate a person having ordinary skill in the art, and with no knowledge of the present invention, to modify Block's frequency counting method from being used to make a correlation between a word and a class, to being used to "locate network data" in the manner of the pending claims.

Mitchell cannot be said to provide the suggestion or incentive required because, as described above, Mitchell does not disclose or suggest using information gleaned from the document itself to locate any network data. That is, because Mitchell does not disclose or suggest using indicia found on a document to locate network data maintained on another device associated with the network, there is no need in Mitchell, thus no suggestion or incentive, to use word frequency to determine anything, much less use word frequency to locate network data in the manner set forth in claims 13 and 28.

Block cannot be said to provide the suggestion or incentive required because Block only discloses using his frequency counting method to calculate an "empirical correlation between a word and a class," not to locate network data.

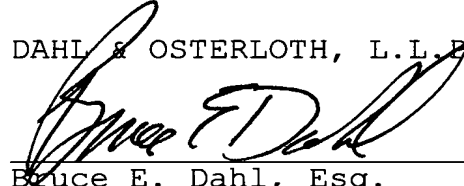
In summation, in rejecting claims 8, 13, 23, and 28 under Section 103, the examiner has done nothing more than to pick and choose from among the prior art only those elements that are contained in the claims without regard to what the prior art

fairly teaches as a whole. Such an activity amounts to hindsight reconstruction and cannot be used as a basis for rejecting claims under Section 103.

Applicant believes that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicant respectfully requests the examiner to reconsider the rejections and to grant an early allowance. If any questions or issues remain to be resolved, the examiner is requested to contact the applicant's attorney at the telephone number listed below.

Respectfully submitted,

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